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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,021	02/12/2002	James J. Finley	1074D2	8098
7590	02/09/2006		EXAMINER	
PIZIALI, ANDREW T				
ART UNIT		PAPER NUMBER		
1771				

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/075,021	FINLEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andrew T. Piziali	1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 November 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 21-37, 43-49 and 51 is/are pending in the application.
- 4a) Of the above claim(s) 48 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 21-37, 43-47, 49 and 51 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 2/12/2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed on 11/30/2005 has been entered. The examiner has withdrawn the rejections of claims 38-42, 50 and 52 based on the cancellations of the claims.

### ***Election/Restrictions***

2. Newly amended claim 48 is now directed to a species that is independent or distinct from the species originally claimed for the following reason: The claim is directed to a non-elected species, wherein the coated product “consists essentially of” a substrate and a metal oxide film. Originally presented and examined claims were drawn to a coated product comprising a substrate, a first metal oxide film, and a second metal oxide film. Since applicant has received an action on the merits for the originally presented species, this species has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 48 is withdrawn from consideration as being directed to a non-elected species. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Rejections - 35 USC § 102/103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-37, 43-47, 49 and 51 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over USPN 5,589,280 to Gibbons et al. (hereinafter referred to as Gibbons).

Regarding claims 21-37, 43-47, 49 and 51, Gibbons discloses a coated product comprising a substrate, a film sputtered from a metal cathode target, such as titanium, in an atmosphere comprising inert gas and reactive gas such that the metal target is sputtered in a metallic mode to deposit a metal film, and a metal oxide film deposited over the metal film (see entire document including column 2, line 6 through column 3, line 10 and lines 38-45, column 5, lines 24-28, column 5, line 63 through column 7, line 35, and column 7, line 64 through column 8, line 14). Gibbons discloses that the film may be oxidized before or after depositing the metal oxide film (column 3, lines 10-25 and column 7, lines 36-44).

Gibbons does not specifically mention whether the film is amorphous, but the current specification discloses that titanium is deposited in a substantially amorphous metallic state by sputtering the metal in a nonreactive atmosphere substantially comprising inert gas, but also comprising a small amount of reactive gas, such as oxygen (see page 3, lines 7-19). Considering that Gibbons discloses that the metal film may be deposited in the “metal mode” (column 7, lines 20-35), and considering that Gibbons discloses that the “metal mode” is known in the art and that the technique comprises sputtering in an inert atmosphere with a limited amount of oxygen so as

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to control the degree of oxidation such that the film is present as a metal rather than a metal oxide (column 7, lines 20-35), it appears that the titanium metal film inherently possesses an amorphous structure.

Due to the identical method of producing the metal film taught by Gibbons, compared to the claimed method, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show obvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Regarding claims 22-24, 32 and 43-44, Gibbons discloses that the metal may be titanium (column 6, lines 1-9).

Regarding claims 25-26 and 46, Gibbons discloses that the metal film may be deposited in the range of 3 to 200 Å (column 2, lines 39-60).

Regarding claims 27-29, 31-34 and 43, Gibbons discloses that the reactive gas may be oxygen (column 7, lines 20-35).

Regarding claims 29-34 and 43, Gibbons discloses that the inert gas may be argon (column 9, lines 9-16).

Regarding claims 32, 35 and 43, Gibbons discloses that the substrate may be glass (column 5, lines 24-28).

Regarding claims 33 and 34, Gibbons does not mention any percent oxygen, but as explained above, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. In addition, Gibbons discloses that the "metal mode" is known in the art and that the amount of oxygen is varied based on the degree of oxidation desired (column 7, lines 20-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the amount of oxygen present, such as between 2 to 15 percent, because it is within the general skill of a worker in the art to select an amount of oxidation on the basis of its suitability.

Regarding claims 36-37 and 43, 49 and 51, Gibbons discloses that the film may be thermally oxidized before or after depositing the metal oxide film (column 7, lines 36-44).

Regarding claims 36-37, 45 and 51, Gibbons discloses that the metal oxide film may be reactively sputtered (column 8, lines 2-14).

Regarding claim 37, Gibbons does not mention any thermal oxidation temperature, but Gibbons clearly discloses that the coated product may be heat treated in an oxygen atmosphere to

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produce thermal oxidation (column 7, lines 36-44). It is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.

Regarding claim 43, Gibbons discloses that the metal of the metal oxide film may be titanium and that the metal oxide film is deposited directly over the film (column 8, lines 2-14).

Regarding claim 44, Gibbons discloses that the metal of the metal oxide film may be titanium (column 8, lines 2-14).

Regarding claim 46, Gibbons discloses that the metal oxide film may have a thickness of less than 10,000 Å, with 20 to 250 Å being typical (column 8, lines 2-14).

Regarding claims 47 and 49, Gibbons does not mention the hardness or density of the metal film (before or after a thermally oxidizing heat treatment), but considering the substantially identical sputtering method of depositing the metal oxide film in an atmosphere comprising inert gas and reactive gas, compared to the method taught by the current specification, it appears that the metal oxide film of Gibbons inherently possesses the claimed properties.

Regarding claim 51, Gibbons discloses that the metal oxide film is deposited directly over the film (column 8, lines 2-14).

***Claim Rejections - 35 USC § 103***

6. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,589,280 to Gibbons as applied to claims 21-37, 43-47, 49 and 51 above, and further in view of USPN 4,188,452 to Groth.

Gibbons discloses that the coated product may be heat treated in an oxygen atmosphere to produce thermal oxidation (column 7, lines 36-44), but Gibbons does not mention a thermal oxidation temperature range. Gibbons is silent with regards to a specific thermal oxidation temperature range, therefore, it would have been obvious to look to the prior art for conventional thermal oxidation temperature ranges. Groth provides this conventional teaching showing that it is known in the art to thermally oxidize titanium oxide films at a temperature of from 400C to 500C (see entire document including column 2, lines 9-18). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to thermally oxidize at a temperature between 400C and 500C, as taught by Groth, motivated by the expectation of successfully practicing the invention of Gibbons.

7. Claims 21-37, 43-47, 49 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,589,280 to Gibbons in view of USPN 4,522,844 to Khanna et al (hereinafter referred to as Khanna).

Regarding claims 21-37, 43-47, 49 and 51, Gibbons discloses a coated product comprising a substrate, a film sputtered from a metal cathode target, such as titanium, in an atmosphere comprising inert gas and reactive gas such that the metal target is sputtered in a metallic mode to deposit a metal film, and a metal oxide film deposited over the metal film (see entire document including column 2, line 6 through column 3, line 10 and lines 38-45, column 5,

lines 24-28, column 5, line 63 through column 7, line 35, and column 7, line 64 through column 8, line 14). Gibbons discloses that the film may be oxidized before or after depositing the metal oxide film (column 3, lines 10-25 and column 7, lines 36-44).

Gibbons does not specifically mention whether the film is amorphous, but the current specification discloses that titanium is deposited in a substantially amorphous metallic state by sputtering the metal in a nonreactive atmosphere substantially comprising inert gas, but also comprising a small amount of reactive gas, such as oxygen (see page 3, lines 7-19). Considering that Gibbons discloses that the metal film may be deposited in the “metal mode” (column 7, lines 20-35), and considering that Gibbons discloses that the “metal mode” is known in the art and that the technique comprises sputtering in an inert atmosphere with a limited amount of oxygen so as to control the degree of oxidation such that the film is present as a metal rather than a metal oxide (column 7, lines 20-35), it appears that the titanium metal film inherently possesses an amorphous structure.

In the event that it is shown that the titanium metal film is not inherently amorphous, Khanna discloses that it is known in the glass and plastic coated substrate art to sputter from a metal target in an atmosphere comprising inert gas and reactive gas to result in a metal film having an amorphous structure with a smooth surface and high corrosion resistance (see entire document including column 1, lines 28-68, column 2, lines 33-44, column 3, lines 31-33). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the metal film amorphous, as taught by Khanna, motivated by the expectation of creating a smooth metal film with high corrosion resistance.

Due to the identical method of producing the metal film taught by the prior art, compared to the claimed method, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.

Regarding claims 22-24, 32 and 43-44, Gibbons discloses that the metal may be titanium (column 6, lines 1-9).

Regarding claims 25-26 and 46, Gibbons discloses that the metal film may be deposited in the range of 3 to 200 Å (column 2, lines 39-60).

Regarding claims 27-29, 31-34 and 43, Gibbons discloses that the reactive gas may be oxygen (column 7, lines 20-35).

Regarding claims 29-34 and 43, Gibbons discloses that the inert gas may be argon (column 9, lines 9-16).

Regarding claims 32, 35 and 43, Gibbons discloses that the substrate may be glass (column 5, lines 24-28).

Regarding claims 33 and 34, Gibbons does not mention any percent oxygen, but as explained above, it is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. In addition, Gibbons discloses that the "metal mode" is known in the art and that the amount of oxygen is varied based on the degree of oxidation desired (column 7, lines 20-35). It would have been obvious to one having ordinary skill in the art at the time the invention was

made to vary the amount of oxygen present, such as between 2 to 15 percent, because it is within the general skill of a worker in the art to select an amount of oxidation on the basis of its suitability.

Regarding claims 36-37 and 43, 49 and 51, Gibbons discloses that the film may be thermally oxidized before or after depositing the metal oxide film (column 7, lines 36-44).

Regarding claims 36-37, 45 and 51, Gibbons discloses that the metal oxide film may be reactively sputtered (column 8, lines 2-14).

Regarding claim 37, Gibbons does not mention any thermal oxidation temperature, but Gibbons clearly discloses that the coated product may be heat treated in an oxygen atmosphere to produce thermal oxidation (column 7, lines 36-44). It is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.

Regarding claim 43, Gibbons discloses that the metal of the metal oxide film may be titanium and that the metal oxide film is deposited directly over the film (column 8, lines 2-14).

Regarding claim 44, Gibbons discloses that the metal of the metal oxide film may be titanium (column 8, lines 2-14).

Regarding claim 46, Gibbons discloses that the metal oxide film may have a thickness of less than 10,000 Å, with 20 to 250 Å being typical (column 8, lines 2-14).

Regarding claims 47 and 49, Gibbons does not mention the hardness or density of the metal film (before or after a thermally oxidizing heat treatment), but considering the substantially identical sputtering method of depositing the metal oxide film in an atmosphere comprising inert

gas and reactive gas, compared to the method taught by the current specification, it appears that the metal oxide film of Gibbons inherently possesses the claimed properties.

Regarding claim 51, Gibbons discloses that the metal oxide film is deposited directly over the film (column 8, lines 2-14).

8. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,589,280 to Gibbons in view of USPN 4,522,844 to Khanna as applied to claims 21-37, 43-47, 49 and 51 above, and further in view of USPN 4,188,452 to Groth.

Gibbons discloses that the coated product may be heat treated in an oxygen atmosphere to produce thermal oxidation (column 7, lines 36-44), but Gibbons does not mention a thermal oxidation temperature range. Gibbons is silent with regards to a specific thermal oxidation temperature range, therefore, it would have been obvious to look to the prior art for conventional thermal oxidation temperature ranges. Groth provides this conventional teaching showing that it is known in the art to thermally oxidize titanium oxide films at a temperature of from 400C to 500C (see entire document including column 2, lines 9-18). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to thermally oxidize at a temperature between 400C and 500C, as taught by Groth, motivated by the expectation of successfully practicing the invention of Gibbons.

***Response to Arguments***

9. Applicant's arguments filed 11/30/2005 have been fully considered but they are not persuasive.

The applicant asserts that Gibbons does not teach or suggest a second oxide film deposited directly over a first oxide film. The examiner respectfully disagrees. Gibbons discloses a coated product comprising a substrate (column 5, lines 24-28), a film sputtered from a metal cathode target, such as titanium, in an atmosphere comprising inert gas and reactive gas such that the metal target is sputtered in a metallic mode to deposit a metal film (column 7, lines 1-60), and a titanium oxide film deposited directly over the metal film (column 8, lines 2-14). Gibbons discloses that the film may be oxidized before or after depositing the metal oxide film (column 3, lines 10-25 and column 7, lines 36-44). Therefore, Gibbons discloses a second titanium oxide film deposited directly over a first titanium oxide (converted from titanium metal) film.

The applicant asserts that because Gibbons discloses the presence of a functional metal layer between the titanium oxide (converted from titanium metal) film and the titanium oxide layer, Gibbons does not disclose a coated product wherein a second oxide film is deposited directly over a first oxide film. The examiner respectfully disagrees. The phrase "directly over" does not exclude the presence of an intermediate layer.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

atp      *g-B 12/16/05*  
**ANDREW T. PIZIALI**  
**PATENT EXAMINER**